

### **REMARKS**

Claims 1-5, 16, 17 and 20-24 are pending in the above-identified application. Claim 14 has been incorporated into claim 1 and claim 5 has been amended so as to be consistent with amended claim 1. Support for new claims 21-24 is found at the bottom of page 45 to line 21 of page 46 of the specification.

#### **Request for Withdrawal of Restriction/Election Requirement**

The Office Action of June 23, 2006 states that claims 12 and 14-19 were withdrawn from consideration pursuant to a “final” Restriction/Election Requirement. Note that Applicant originally elected claims which recited formula (II) in the Reply to Restriction Requirement filed November 7, 2005. Presently, the claims have been narrowed so as to recite formula (7) which falls completely within the scope of originally elected subject matter including formula (2) and is completely consistent with the species election of resin (a1) and (a2) described at the top of page 60 of the present specification. Presently, the “withdrawn” claims include claims 16 and 17. However, claims 16 and 17 recite formulas (8), (8-1), (9) and (9-1) which all fall within the scope of formula (7). It is submitted that there is a complete overlap with regard to examination and patentability issues concerning presently elected claims 1-5 and 20-24, and the subject matter recited in presently “withdrawn” claims 16 and 17. Thus, there is no significant burden placed on the Examiner to examine non-elected claims 16 and 17, such that the Restriction/Election Requirement should be withdrawn.

#### **Interview Conducted with Patent Examiner**

Applicant appreciates the fact that the Examiner granted a personal interview with Applicant’s representative on August 24, 2006. As stated in the Interview Summary form, the substance of the Interview included the following:

Applicant proposed amendment to correct the 112 issues and narrow the claims to overcome the cited (prior) art. Applicant also indicated that they felt the finality of the last office action was

premature as the art cited was cited for the first time. The Examiner pointed out that the search that resulted in the prior art was necessitated by the clarification of the claims in response to the first Office Action. Thus, the amendment necessitated the newly cited art.

The above-noted issues discussed at the Interview are addressed below.

*Reasons Supporting Entry of Claim Amendments under 37 CFR 1.116(b)*

It is respectfully submitted that the amendment to the claims should be entered under 37 CFR 1.116(b)(2), since the claims have been narrowed and clearly placed into better form for consideration on appeal, should an appeal be necessary. Also, pursuant to 37 CFR 1.116(b)(3), the amendments to the claims were necessary in order to avoid the newly cited prior art and could not have been presented earlier, since the prior art references were not cited earlier. Consequently, it is submitted that the amendment to the claims should be entered of record.

*Reasons that Office Action Was Prematurely Made "Final"*

Applicant's representative understands the position stated by the Examiner at the Interview that the new grounds of rejection under 35 USC 102(e) and 103(a) was necessitated by the amendments to the claims submitted in the Amendment filed April 27, 2006. However, a close review of the minor changes made to claim 1 in the April 27th Amendment indicates that indeed the changes made to claim 1 did not necessitate a new ground of rejection. Note that claim 1 was amended as follows: (1) "at least one" was changed to --one or more--; (2) "may be substituted" was changed to --is optionally substituted--. Applicant did comply with the suggestion with the Examiner to make these changes; however, these changes to claim 1 did not change the scope of the claim with respect to the prior art. No other claim changes were made and the previous Office Action of January 27, 2006 cited no prior art. It is not understood how changes (1) and (2) to claim 1 could have necessitated the new grounds of rejection under 35 USC 102 (e) and 103(a) which relays upon newly cited prior art for the first time. Consequently,

it is respectfully submitted that the Office Action of June 23, 2006 was prematurely made “final” taking into account the standards stated in MPEP 706.07(a).

*Request for Entry of Claim Amendments*

In view of the above-stated reasons supporting entry of the amendments to the claims under 37 CFR 1.116(b)(2) and (b)(3), as well as the reasons in support of the conclusion that the Office Action of June 23, 2006 was prematurely made “final” under MPEP 706.07(a) standards, it is respectfully requested that the presently submitted amendments to the claims be entered of record and fully considered by the Examiner. As noted below these amendments to the claims remove the basis for the Rejection under 35 USC 103(a).

*Removal of Bases for Rejections under 35 USC 102(e) and 103(a)*

Claims 1-11, 13 and 20 have been rejected under 35 USC 102(e) as being anticipated by Iwasawa '082 (USP 2004/0143082 A1).

Claims 1-11, 13 and 20 have been rejected under 35 USC 103(a) as being unpatentable over Taylor '060 (US 2002/0055060 A1) in combination with Kodama '370 (USP 6,858,370).

The claims of the present application have been amended so as to require that the resin (A) include the structural unit of formula (7). All of Iwasawa '082, Taylor '060, and Kodama '370 fail to disclose or suggest a resist composition which includes a resin component (A) having a structural unit of formula (7) as recited in the present claims. Therefore, there is no basis for alleging anticipation or non-obviousness in view of these cited references since a required element of the present claims is absent from the disclosure of these references. Consequently, it is requested that each of the above-noted rejections be withdrawn.

It is submitted for the reasons above that the present claims define patentable subject matter such that this application should now be placed in condition for allowance.

If any questions arise in the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 25, 2006

Respectfully submitted,

By   
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